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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/896,060	07/17/1997	STEPHEN C. LAKES	M5251CEMY/LU	.2705

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COGNIS CORPORATION
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EXAMINER

MEDLEY, MARGARET B

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 07/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/896,060

Applicant(s)

LAKES ET AL.

Examiner

Margaret B. Medley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 11-16 and 20-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11-16 and 20-39 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to Paper No. 9 dated March 26, 2002.

The amendment, Paper No. 2, date July 17, 1997 canceling claims 5-10, 17-19 and 40-41 has been entered of record.

The amendment, Paper No. 3 dated July 17, 1997 amending claims 11-12, 14-16, 20, and 30-31 has been entered of record/

The pending claims of record are claims 1-4, 11-16 and 20-39.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 1-4, 11-16 and 20-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis 4,708,809 in view of Mullin 4,780,229 and Schmid et al (Schmid) 5,057,247.

Davis teaches and discloses two cycle engine oil lubricants, note the abstract, comprising neopentylol esters and method of lubricating a two cycle engine, column 2, lines 29-42, wherein the lubricating oil includes ester oils made from C₅-C₁₂, monocarboxylic acids and polyols including trimethylol propane, pentaerythritol, dipentaerythritol, tripentaerythritol, column 3 lines 36-40, wherein fatty acid ester oils of polyols such as pentaerythritol and trimethylol propane are typical useful synthetic oils, column 16, lines 48-50. In general the two-cycle engine lubricating oil compositions contain about 98 to about 55% typically 70-96% oil or mixture of lubricating viscosity, column 16, lines 41-44. Patentee further provides for the further inclusion of additives e.g., @ 2-30%, typically @ 1-20% ,column 16 lines 51-60, column 34 line 33 to column 35 line 19, of at least one alkyl phenol, phenate, column 21 lines 29-65, alkenylsuccinimide, column 25, lines 3-6, phenolic amine, column 25, lines 49-63. Davis further teaches 1 part oil to about 15-250 part, typically 50-100 parts fuel, note column 35, lines 41-54.

Davis is silent to the instant claimed mixture of neopentyl esters and that the mixture of esters having biodegradable properties.

Mullin teaches and discloses a lubricant composition consisting essentially of a polyol ester blend of TMP tri-isostearte and TMP pelargonate, triaryl phosphate ester and a mineral oil base crankcase additive, column 2, line 39 to column 3, lines 1-9 and

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29-56 and claims 1-4. Patentee further teaches that mixtures of monocarboxylic acid of (C₄-C₁₈, typically mixtures of C₆, C₇ and C₂ and dicarboxylic acid can be used if an increased viscosity is desired in the final product, column 3, lines 46-48. Suitable dicarboxylic acids include 3 to 12 carbon atoms, particularly adipic and azelaic acid, column 3, lines 54-56.

Schmid teaches and discloses lubricant oils comprising a synthetic complex polyol esters derived from a polyol and a branched C₈₋₁₆ fatty acid or mixture of linear C₈₋₁₄ fatty acids typical caprylic and capric acid, e.g., Example 5 with branched C₈₋₁₆ fatty acid with a polybasic carboxylic acid including di, e.g., adipic acid, tri acids etc., abstract, column 1, line 39 to column 2, lines 1-12 and 24-46, column 3, lines 58-67. Patentee further provides for the inclusion of conventional lubricant additives, column 4, lines 67 to column 4, line 1.

The secondary references clearly teach that the instant claimed blend or mixture of esters are well known and are conventionally used as lubricant based fluids. The secondary references provide the motivation for selecting their blend or mixture of esters as the synthetic ester blend of the primary reference rendering the instant claims obvious. The examiner takes the position on record that the biodegradable properties would inherently be present in the esters of the secondary references that are of the same ester of the instant claims. Esters that are the same are reasonably expected to have the same properties and characteristics.

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The prior art made of record and not relied upon further teaches polyol esters and two-cycle lubricant fluid and their use of the same nature as that of the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Monday-Friday from 7:30 am to 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


MARGARET MEDLEY
PRIMARY EXAMINER

M. B. Medley/mn
July 22, 2003